



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

WILLIAM PATRICK APPS

Group Art Unit: 3727

Examiner: S. Castellano

Serial No.: 09/785,100

Filed: February 15, 2001

For: NESTABLE DISPLAY CRATE FOR BOTTLE CARRIERS

Attorney Docket No.: RPC 0559 PUS

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
OCT 08 2003
TECHNOLOGY CENTER R5/00

Sir:

This is an appeal brief from the second rejection of claims 1-51 of the Office Action dated April 3, 2003. This application was filed on February 15, 2001.

The present application is a continuation of application Ser. No. 09/399,990, filed September 20, 1999, now abandoned, which is a continuation of application Ser. No. 08/921,153, filed August 29, 1997, now U.S. Patent No. 5,979,654.

10/07/2003 AWONDAF1 00000003 09785100

01 FC:1402
02 FC:1251

320.00 OP
110.00 OP

I. REAL PARTY IN INTEREST

The real party in interest is Rehrig Pacific Company as set forth in the assignment in the grandparent application recorded in the U.S. Patent and Trademark Office on August 29, 1997 at Reel 8705, Frame 0693.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

9/29/03
Date of Deposit

Robert C. Brandenburg
Name of Person Signing

Signature

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals and/or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the present appeal. Appellant originally appealed from the final rejection of claims 1-51 of the Office Action dated May 27, 2002. After Appellant briefed the initial appeal, the Examiner reopened prosecution. The resulting Office Action dated April 3, 2003, appealed in this proceeding, continued the same art rejections and added obvious-type double patenting rejections.

III. STATUS OF CLAIMS

Claims 1-51 (*see* Appendix attached) are pending in this application. The rejection of the claims has been made final. Appellant hereby appeals the rejection of all claims 1-51.

IV. STATUS OF AMENDMENTS

No amendments have been made following the Office Action dated April 3, 2003.

V. SUMMARY OF THE INVENTION

Bottles, particularly for soft drinks and other beverages, are often stored and transported during distribution in crates. These crates generally are configured to be stacked on top of each other when loaded with bottles, and nested together when empty of bottles. The plastic crates provide advantages such as conservation of storage space and efficient, easy handling and recyclability. In order to minimize the storage space of the crates when nested and to reduce cost and weight, many crates today are made with a shallow peripheral sidewall structure. These "low depth" crates are used extensively. Generally, it is desirable to design low depth crates with a wall structure that provides lateral support for the bottles while also allowing the bottles to be visible.

Crates for single serve bottles are customarily stacked on top of each other. One way of handling the loaded crates is to stack the cases on pallets which can be lifted and moved about by fork-lift trucks. A technique for interconnecting loaded crates is called cross-stacking, and is often used to improve stability of a stack of crates for transport or for display purposes by a retailer. An aspect of crate design is to provide the structural features which facilitate handling of stacked and cross-stacked loaded crates to enhance the stability of stacked crates, while providing maximum visibility of the bottles or bottle carrier, especially in a retail setting.

A problem experienced with previous nestable crates has been somewhat limited visibility of the bottle or container labels. The obscured visibility problem has been more pronounced when the bottles are grouped together in a cardboard carrier or otherwise bundled because present crates are not designed to show the labels on the carriers or shrink wrap. There is a need for a nestable display crate for bottle carriers or multi-packs which has improved structural strength and provides bottle carrier visibility.

According to the embodiment of the invention disclosed, the low depth nestable display crate (10) for bottle carriers (C) has a floor (16) for supporting the bottle carriers and a wall structure having endwalls and sidewalls extending around the periphery of the floor. A lower wall portion includes an exterior surface (20) along the sidewalls connected to the floor for supporting the carriers. A double thickness upper wall portion (14) has spaced tooth members (22) extending upward from the lower wall portion which define display openings between the tooth members along the sidewalls sized to reveal labels L on the bottle carriers for displaying the bottle carriers in a loaded crate.

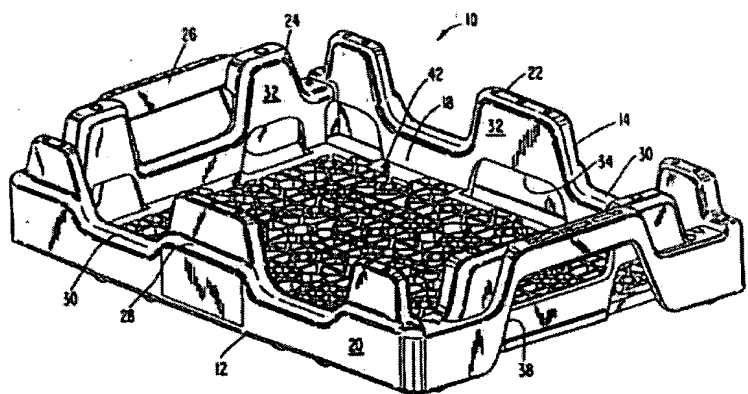
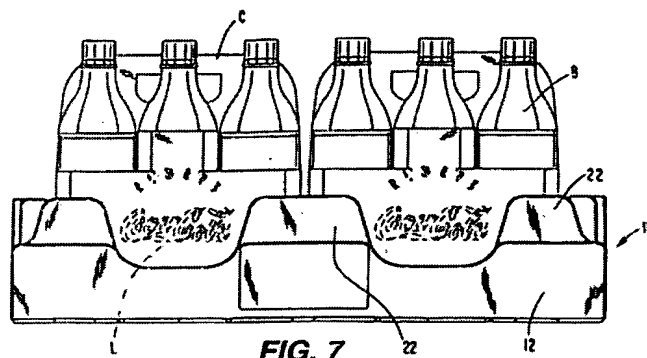


FIG. 1

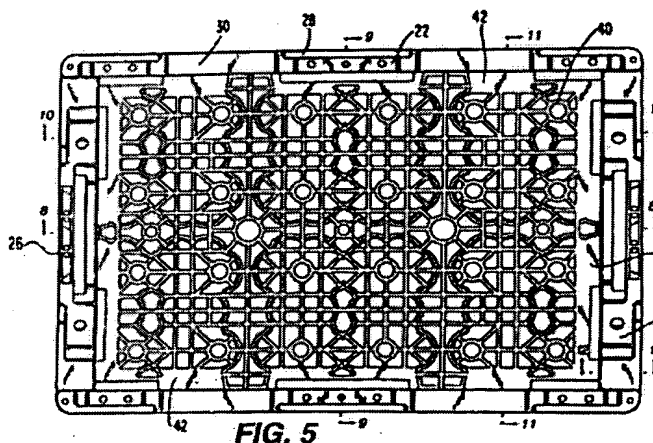
The spaced tooth members (22) in one embodiment have a trapezoidal shape and an upper edge with at least one rounded portion. The tooth members have an upper portion, and a bottom portion having a relatively greater width than the upper portion. Nesting ribs (23, 25) are



provided within at least one of the tooth members to bear against a top surface of a corresponding tooth member in a crate nested therebelow. The tooth members extend above and inwardly from said lower wall portion along the sidewalls to form a shoulder therebetween.

The tooth members include interior teeth panels (32) which are flat to provide lateral support to the bottle carriers loaded in the crate. The interior teeth panels are generally coplanar with the interior bottle carrier support surfaces (18). There is a cut-out (34) disposed below the interior teeth panels.

A handle bar (26) is integrally molded with the tooth members (22) along the endwalls. The lower wall portion defines a cut-out (38), which provides the handle bar clearance below the handle bar, and clearance above the handle bar from a stacked crate above, and provides sufficient clearance between the handle bar and the bottle carriers loaded in the crate to enable a user's hand to encircle the handle bar. The sidewall lower wall portion (12)



between the spaced tooth members (22) includes an outer wall member having a solid outer surface (20) and an inner surface (18), with the inner surface having a plurality of ribs extending inwardly perpendicular therefrom. Extending between the exterior surface and the interior portions of the lower wall portion is a flat lower wall top surface (30).

VI. ISSUES

- Issue A:** The Examiner has erred in rejecting claims 1-51 under 35 U.S.C. § 102(e) as being clearly anticipated by U.S. Patent No. 5,651,461 to Apps et al. (Apps '461);
- Issue B:** The Examiner has erred in rejecting claims 15-19, 21-26, 50 and 51 under 35 U.S.C. § 102(e) as being clearly anticipated by U.S. Patent No. 5,704,482 to Apps et al. (Apps '482);
- Issue C:** The Examiner has erred in rejecting claims 28-30, 32-39 under 35 U.S.C. § 102(b) and/or § 102(e) as being clearly anticipated by U.S. Patent No. 5,465,843 to Koefeldt (Koefeldt '843);
- Issue D:** The Examiner has erred in rejecting claims 1-51 under the judicially created doctrine of double patenting over claims 1-5 of U.S. Patent No. 5,979,654 to Apps (Apps '654); and
- Issue E:** The Examiner has erred in rejecting claims 1-51 under the judicially created doctrine of double patenting over drawing figures 1-12 of U.S. Patent No. D400,012 to Apps (Apps '012).

VII. GROUPING OF CLAIMS

The rejections of claims 1-51 are contested. The claims do not stand or fall together.

For purposes of this appeal only and based upon the underlying rejections being appealed, Appellant groups the claims as follows.

(I) Claims 1, 3-14, 20, 27, 31, 40-49 will be identified as Group I claims and stand or fall together. The group is directed to claims solely rejected on the basis of being anticipated by Apps '461, other than the double patenting rejections.

(II) Claim 2 will be identified as Group II claim and will stand or fall by itself. This group is directed to a claim that was solely rejected on the basis of Apps '461 and which has an additional limitation, not shown in the reference, that the interior teeth panels are flat to provide lateral support to bottle carriers loaded in the crate, other than the double patenting rejections.

(III) Claims 15, 17-19, 21-26, 50 and 51 will be identified as Group III claims and stand or fall together. The group is directed to claims rejected on the alternative bases of being anticipated by Apps '461 or Apps '482, in addition to the double patenting rejections.

(IV) Claim 16 will be identified as Group IV claim and will stand or fall by itself. This group is directed to a claim rejected on the alternative bases of being anticipated by Apps '461 or Apps '482 and which has the additional limitation, not shown in the references, that the tooth members have interior teeth panels which are flat and co-planar with the interior bottle carrier support surfaces, in addition to the double patenting rejections.

(V) Claims 28-30, 32, 34-39 will be identified as Group V claims and stand or fall together. The group is directed to claims rejected on the alternative bases of being anticipated by Apps '461 or Koefeldt '843, in addition to the double patenting rejections.

(VI) Claim 33 will be identified as Group VI claim and will stand or fall by itself. The group is directed to a claim rejected on the alternative bases of being anticipated by Apps '461 or Koefeldt '843 and which has the additional limitation, not shown in the references, that the interior teeth panels are flat for providing lateral support to the bottle carriers, in addition to the double patenting rejections.

VIII. ARGUMENT

The present invention pertains to crates used to store, transport and display bottle carriers, such as six packs. For marketing purposes, it is often advantageous to allow shoppers to see as much of the six pack graphics as possible. The crates should also be stackable and strong for easy and convenient transportation and storage. Thus, the invention presents a crate that is nestable, has improved and structural strength and provides bottle carrier visibility.

A. Prior Art Rejections Unjustified

The prior art fails to show or suggest such a carrier. Despite this, the Examiner rejected the claims based on three prior patents to the assignee of this application, Rehrig Pacific Company. Although all the claims are restricted to crates for bottle carriers (*see*, preambles and repeated references to bottle carriers in the bodies of the independent claims 1, 15, 28, 40, 50 and 51), the art relied upon by the Examiner as anticipating all the claims were crates for individual bottles, not suitable for bottle carriers. Therefore, it is important to understand the art cited by the Examiner.

The Prior Art**1. Apps et al. '461**

Apps et al. U.S. Patent No. 5,651,461 is a stackable case (10) for retaining and transporting individual bottles (9). Mr. Apps is the inventor on the pending application. This patent and the pending application are both assigned to Rehrig Pacific Company.

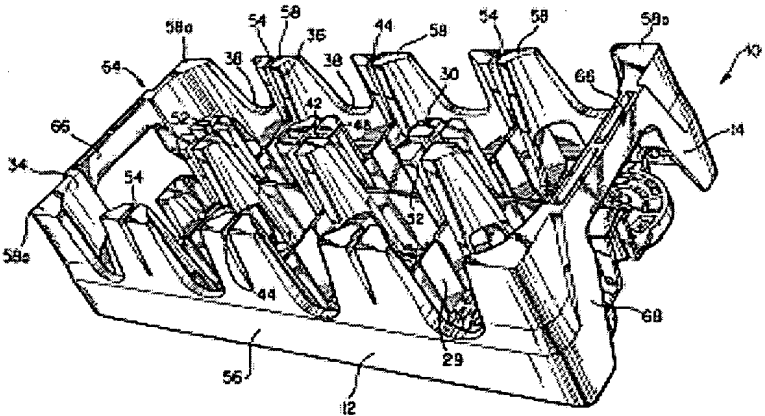


FIG. 1

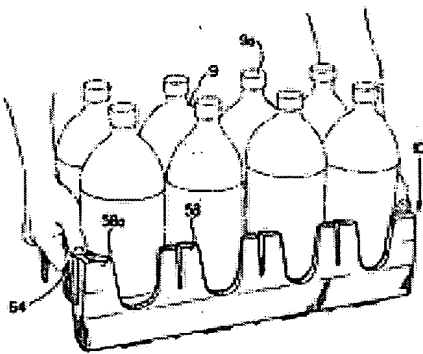


FIG. 14

Each individual bottle (9) is retained within its own corresponding bottle retaining pocket (32). The interior pockets are defined by four separate upwardly projecting columns 30 or pylons 58. The exterior bottle retaining pockets are formed by corner pylons 58a, side pylons 58, and columns 30. Interior walls (29) separate the pockets from one another. (Column 6, line 1 - line 48.)

There is no suggestion that the crate could be used with cartons of bottles. The interior walls, columns, and irregular interior surface of the side walls do to the pylons make such use impossible.

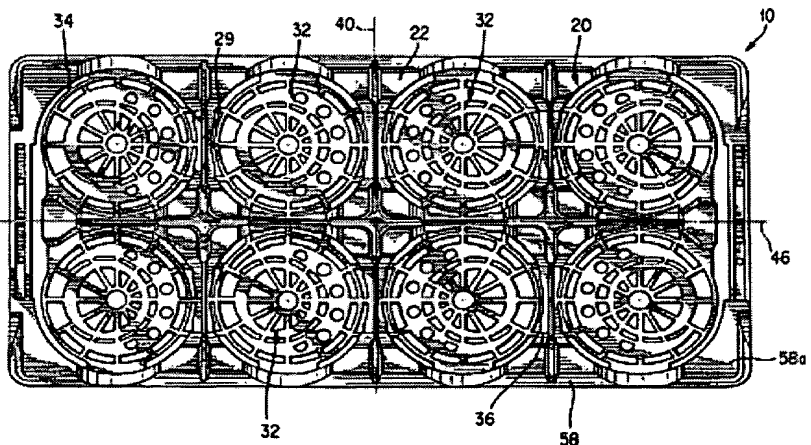


FIG. 2

2. Apps et al. '482

Apps et al. U.S. Patent No. 5,704,482 is another stackable case (20) for retaining and transporting individual bottles. This patent is also assigned to Rehrig Pacific Company.

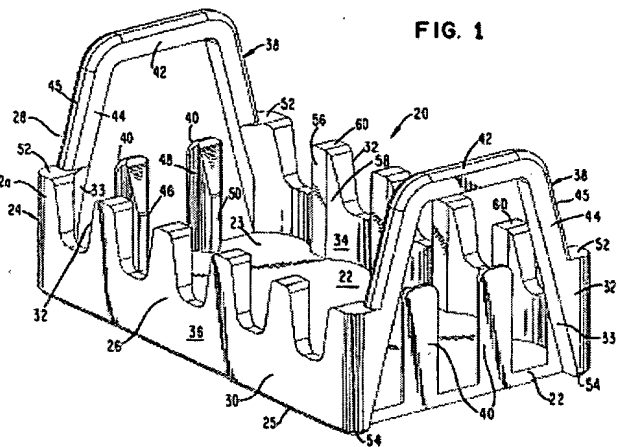
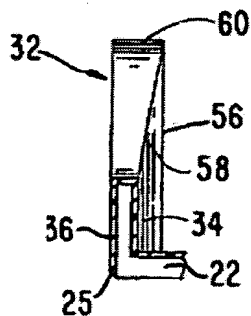


FIG. 1

FIG. 4



Pylons (32) are regularly

spaced along sidewalls (26). Each pylon includes a center panel (56) which is arranged to protrude between adjacent bottles when the crate (20) is loaded.

See, FIG. 9. Therefore, the center panels 56 are inwardly displaced from the interior surface (34) of the lower wall portion (30). The center panels of adjacent pylons (32) are connected by curved transition portions (58) and the interior surface (34) of the lower wall (30). When the crate (20) is loaded with bottles, the sides of the bottles are supported by curved transition portions 58 to snugly hold the bottles therein. (Column 6, line 31 - line 49.)

The crate retains bottles in relatively close relation so as to prevent jostling during handling. Excess bottles movement is to be avoided in order to ensure that they remain in a vertically upright position to most advantageously bear the load of crates stacked thereabove. (Column 4, line 23 - line 31.)

There is no suggestion that the crate could be used with cartons of bottles. Due to the protrusion of the pylons inwardly, such use would be impossible.

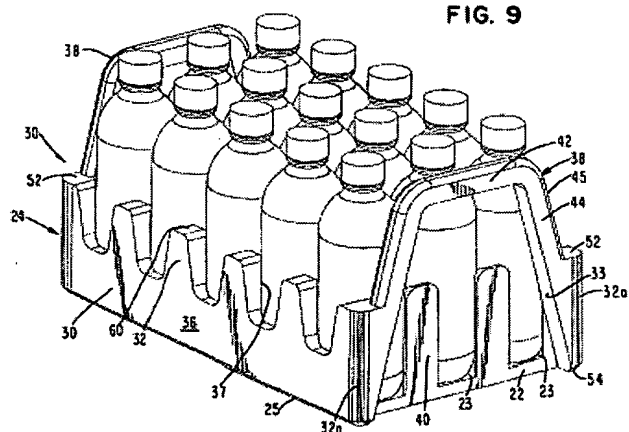
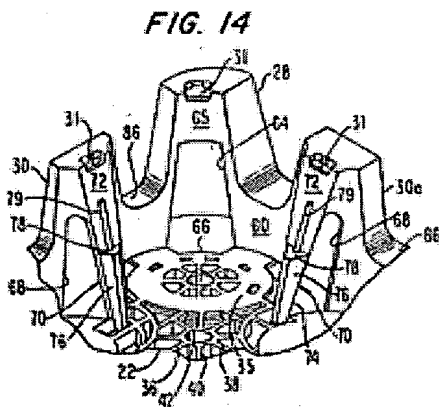


FIG. 9

3. Koefelda '843

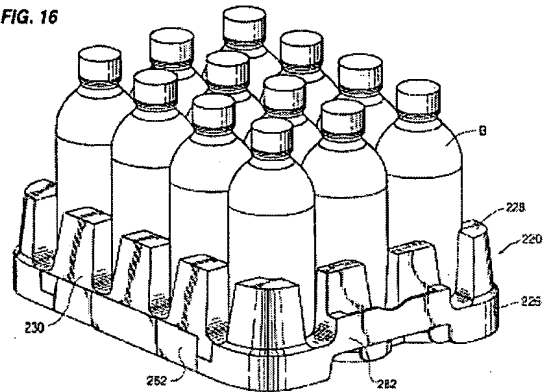
Koefelda U.S. Patent No. 5,465,843 is yet another stackable case (20) for retaining and transporting individual bottles. It is also assigned to Rehrig Pacific Company.



when crate 20 is loaded with bottles. (Column 7, line 62 - column 8, line 2.)

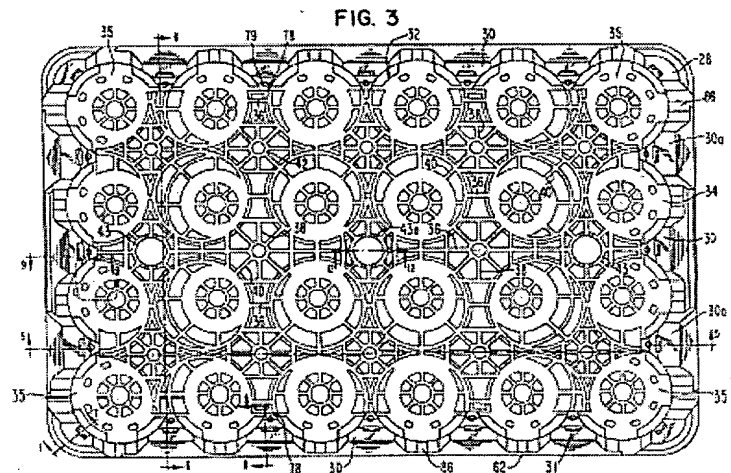
There is no suggestion that the crate could be used with bottle cartons. The central panels of the pylons protrude inwardly between the bottles, making such use impossible.

FIG. 16



The wall

structure defines the periphery of crate 20 and comprises a lower wall portion 26 and a plurality of corner pylons 28 and side pylons 30 and 30a. The interior sides of side pylons 30 and 30a have an integral central panel 70. The central panels are preferably angled outwardly from the floor toward the top of the pylons. In this way, central panels 70 will extend somewhat between adjacent bottles



ISSUE A: The Examiner has erred in rejecting claims 1-51 under 35 U.S.C. § 102(e) as being clearly anticipated by Apps '461.

In the initial Office Action of 10/19/01, the Examiner stated without analysis that "Claims 1-51 are rejected under 35 U.S.C. § 102(e) as being anticipated by Apps et al. ('461)." Applicant traversed this rejection. It was pointed out that Claims 1-51 are directed to a crate for supporting bottle carriers. Apps '461 teaches a crate designed to provide stability for individual bottles. For instance, Apps '461 includes surfaces 36 and columns 30 extending between adjacent bottles when the crate is loaded with individual bottles. Thus, as shown above, Apps '461 does not show a crate suitable for use with bottle carriers. For example, the current application does not have surfaces 36 extending between bottles as shown in Apps '461 because they would interfere with the bottle carriers, making it difficult or impossible for them to seat properly.

In contrast to the reference, dependent claim 2 recites interior teeth panels that are flat to provide lateral support to bottle carriers loaded in the crate. No such structure is found in Apps '461. Although this was pointed out numerous times, the Examiner never addressed this issue.

Moreover, by way of example and not limitation, the following claims are also not disclosed or taught in Apps '461. Claim 16 is directed to the tooth members having interior teeth panels which are flat and co-planar with the interior bottle carrier support surfaces. Such feature is not disclosed in Apps '461, and claim 16 is therefore not anticipated by this reference. Claim 22 is directed to the spaced tooth members having an upper edge with at least one rounded portion; claim 27 includes a lower wall portion between spaced tooth members having an outer wall with an inner surface and a plurality of ribs extending inwardly perpendicular therefrom. Such features are not taught in Apps '461, and claims 22 and 27 are also not anticipated by Apps '461.

The Examiner responded to Applicant's arguments in the May 27, 2002 Office Action by making the rejection final with only the following statement:

"Applicant's arguments filed April 30, 2002 have been fully considered but they are not persuasive. Applicant states that the crate is intended for supporting bottle carriers and that

the references provide support only for individual bottles rather than bottle carriers. The same surfaces that can support the individual bottles are just as capable of supporting bottle carriers.”

No such surfaces are identified by the Examiner. The only supporting bottles surfaces in Apps ‘461 are found in single bottle supporting pockets separated by walls and columns. (*See, e.g.*, column 6 lines 7-27, Figures 1 and 2). Thus, they cannot support carriers, which have multiple bottles. Further, the Examiner ignored Applicant’s individual claim specific arguments. This was pointed out in the initial appeal brief.

Upon reopening prosecution, the only explanation for the rejection was:

“Apps et al. (‘461) discloses a low depth nestable display crate which holds two liter beverage bottles made of polyethylene terephthalate (PET) material and is inherently capable of holding bottle carriers such as beverage cozys with a beer bottle in each beverage cozy.”

No “beverage cozy” is identified nor recognized in relation to the beverage crate art. Apps ‘461 does not mention the holding of beverage carriers or beverage cozys. The unsupported allegation of an inherent ability to hold unidentified bottle carriers, “such as” unidentified beverage cozys does not establish a *prima facie* case of anticipation.

Accordingly, claims 1-51 are patentable over Apps ‘461 and are not anticipated.

ISSUE B: The Examiner has erred in rejecting claims 15-19, 21-26, 50 and 51 under 35 U.S.C. § 102(e) as being clearly anticipated by Apps ‘482.

As with the other rejections, this rejection was summarily set forth in the May 27, 2002 Office Action with no further explanation by the Examiner other than the statement in the final rejection quoted above.

Applicant traversed this rejection also. Like the rejection above, these claims are directed to a crate for supporting bottle carriers and sidewall lower wall portions having “interior *bottle carrier* support surfaces.” Such features are not disclosed in Apps ‘482 and thus the rejected claims are not anticipated thereby. To the contrary, Apps ‘482 teaches

individual bottle support surfaces on pylons that protrude into the interior of the crate, preventing its use for carriers.

Also, claim 16 is directed to the tooth members having interior teeth panels which are flat and co-planar with the interior bottle carrier support surfaces. Such feature is not disclosed in Apps '482, and claim 16 is therefore not anticipated by this reference. This feature, while addressed by Applicant numerous times, was never addressed by the Examiner.

Upon reopening prosecution, the only explanation for the rejection was:

“Apps et al. ('482) discloses a low depth nestable display crate which holds beverage bottles and is inherently capable of holding bottle carriers such as beverage cozys with a beer bottle in each beverage cozy or larger two-pack, four-pack, six-pack or eight-pack bottle carriers.”

Again, no “beverage cozy” is identified nor recognized in relation to the beverage crate art. Apps '482 does not mention the holding of beverage carriers or beverage cozys. The unsupported allegation of an inherent ability to hold unidentified bottle carriers, “such as” unidentified beverage cozys does not establish a prima facie case of anticipation.

The “larger two-pack, four-pack, six-pack or eight-pack bottle carriers” are not identified. However, for the reasons set forth above, it is not seen how Apps '482 would adapted to handle “two-pack, four-pack, six-pack or eight-pack bottle carriers.”

Accordingly, these claims are patentably distinguished over the cited reference and not anticipated.

ISSUE C: The Examiner has erred in rejecting claims 28-30 and 32-39 under 35 U.S.C. § 102(b) and/or (e) as being clearly anticipated by Koefeldt '843.

As with the other rejections, this was summarily stated in the May 27, 2002 Office Action with no further explanation by the Examiner other than the statement in the final rejection quoted above.

Like the rejections above, these claims are directed to a crate for supporting bottle carriers and sidewall lower wall portions having “interior *bottle carrier* support surfaces.” Such features are not disclosed in Koefeldt '843 and thus the rejected claims are

not anticipated thereby. Again, use with bottle carriers is not taught. The protrusion of the central panels of the pylons inwardly is possible due to the space between individual bottles, but would conflict with the carriers.

Further, claims 28-30 and 32-39 do not include many other limitations of the present claim. For example, independent claim 28 as amended includes a handle bar which may be encircled by a user. Such feature is not disclosed in Koefeldt '843. Further, by way of example, claim 33 is directed to interior teeth panels which are flat for providing lateral support to the bottle carriers. Central panel 70 of Koefeldt '843 does not provide such lateral support. Accordingly claim 28 and dependent claims 29-30 and 32-39 are not anticipated by this reference. None of these additional limitations were ever specifically addressed by the Examiner, despite being raised by Applicant numerous times.

Upon reopening prosecution, the only explanation for the rejection was:

“Koefeldt ('843) discloses a low depth nestable display crate which holds one liter beverage bottles (B) in a 3 by 5 array (see Fig. 16-18) and is inherently capable of holding bottle carriers such as beverage cozys with a beer bottle in each beverage cozy or larger two-pack, four-pack, six-pack or eight-pack bottle carriers.”

Again, no “beverage cozy” is identified nor recognized in relation to the beverage crate art. Koefeldt '843 does not mention the holding of beverage carriers or beverage cozys. The unsupported allegation of an inherent ability to hold unidentified bottle carriers, “such as” unidentified beverage cozys does not establish a prima facie case of anticipation.

The “larger two-pack, four-pack, six-pack or eight-pack bottle carriers” are not identified. However, for the reasons set forth above, it is not seen how Koefeldt '843 would adapted to handle “two-pack, four-pack, six-pack or eight-pack bottle carriers.”

Thus, these claims are patentable over the cited reference and not anticipated.

B. No Double Patenting

All the claims have been rejected under the judicially created doctrine of double patenting over claims 1-5 of Apps '654 and drawing Figures 1-12 of U.S. Patent No. D400,012 to Apps. Due to the failure of the Examiner to provide a *prime facie* case and the differences in claim scope, these rejections should be overturned.

Issue D: The Examiner has erred in rejecting claims 1-51 under the judicially created doctrine of double patenting over claims 1-5 of Apps '654.

The MPEP § 804 states:

“In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is—does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? If the answer is yes, then an ‘obvious-type’ nonstatutory double patenting rejection may be appropriate.

* * *

“Any obvious-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

“When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art.”

In the Office Action dated April 3, 2003, the Examiner’s explanation of the double patenting rejection reads:

“Claims 1-51 are rejected under the judicially created doctrine of double patenting over claims 1-5 of U.S. Patent No. 5,979,654 to Apps and over drawing figures 1-12 of U.S. Patent No. D400,012 to Apps since the claims, if allowed, would improperly extend the “right to exclude” already granted in the patent.

“The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A low depth nestable display crate for six-pack bottle carriers comprising a floor, a double thickness wall structure having a lower wall portion, an upper wall portion and a handle bar.

“Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.”

The Examiner improperly (a) treats the prior patent disclosure as prior art; (b) does not attempt to address the differences between the claims of the pending application and the claims of the reference, concentrating on their “common subject matter” in a summary fashion; and (c) fails to explain why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

A proper analysis shows the double patenting rejection is improper.

Claims 1-5 of Apps ‘654 read:

1. A low depth nestable display crate for six-pack bottle carriers comprising:
a floor for supporting the bottle carriers; and
a doubled thickness wall structure having endwalls and sidewalls extending around the periphery of said floor and comprising
a lower wall portion including a solid exterior surface along said sidewalls and interior bottle carrier support surfaces connected to said floor,
an upper wall portion comprising spaced tooth members extending upward from said lower wall portion and defining display openings between said tooth members along said sidewalls, wherein said display openings are sized to reveal labels on the bottle carriers for displaying the bottle carriers in a loaded crate, and
a handle bar integrally molded with said tooth members along said endwalls and said lower wall portion defining a cut-out, said cut-out providing said handle bar complete clearance below said handle bar, and complete clearance above said handle bar from a stacked crate thereabove, and provide sufficient clearance

between said handle bar and the bottle carriers loaded in said crate to enable a user's hand to completely encircle said handle bar.

2. The crate of claim 1, comprising interior teeth panels provided on the interior side of said tooth members, said teeth panels being flat to provide lateral support to the bottle carriers loaded in said crate.

3. The crate of claim 1, wherein said interior surface of said lower wall portion includes an alternating arrangement of interior panels connected to said floor and cut-outs.

4. The crate of claim 1, wherein said tooth members extend above and inwardly from said lower wall portion to form a shoulder therebetween.

5. The crate of claim 1, further comprising nesting ribs provided within at least one of said tooth members to bear against a top surface of a corresponding tooth member in a crate nested therebelow.

A comparison of the pending independent claims to claims 1-5 of Apps '654 show significant, non-obvious differences. Set forth below are the differences for each independent claim versus claim 1 of Apps '654, with the dependent claims not suggesting the differences.

Pending claim 1 significantly broadens the coverage due applicant by eliminating the Apps '654 limitation that the bottle carriers be six packs. The wall structure no longer is stated as doubled thickness, although such a limitation is directed to the upper wall portion of the wall structure. Other literal changes include that the exterior of the lower wall portion no longer needs to be solid nor must the user's hand "completely" encircle said handle bar.

Pending claim 15 has more extensive changes, including eliminating the limitation found in Apps '654 that the bottle carriers be six packs and by adding further definition to the floor. The reference to a doubled thickness wall structure has been eliminated. The claim includes a pair of opposed endwalls and a pair of opposed sidewalls extending around the periphery of said floor. The sidewall has a double thickness upper wall portion including spaced-apart sidewall tooth members extending upwardly from said sidewall lower wall portion. These and other changes make the claim unobvious over Apps '654 claims.

The third pending independent claim 28 also significantly broadens the coverage due applicant by eliminating the limitation found in Apps '654 that the bottle carriers be six packs. The wall structure no longer is stated as doubled thickness, although such a limitation is directed to the upper wall portion of the wall structure. Other changes include further definition of the relationship between a lower wall portion and the upper surface of the floor and between the exterior and interior surfaces of the lower wall portion. The entire clause relating to the amount of clearance between the handle bar and bottle carriers is eliminated.

Pending independent claim 40 significantly broadens the coverage since the wall structure is no longer stated as doubled thickness. It also defines a lower wall portion including an exterior wall member along said sidewalls with the exterior wall member having an outer surface and an inner surface. The inner surface has a plurality of rib members projecting perpendicularly therefrom. The lower wall portion further has interior portions for supporting bottle carriers with the interior portions connected to the floor. These and other changes make for an unobvious claim in view of the claims of Apps '654.

Pending claim 50 removes the limitation that a lower wall portion includes a solid exterior surface.

Pending claim 51 significantly broadens the coverage due applicant by eliminating the limitation found in Apps '654 that the bottle carriers be for six packs. The wall structure is no longer stated as doubled thickness. The description of the upper wall portion is extensively rephrased including that the upper wall portion be double-walled with tooth members having an upper surface, at least a portion of which is rounded. The handle bar language is significantly rephrased including elimination of the entire clause relating to the amount of clearance between the handle bar and bottle carriers

Thus, it can be seen that numerous differences are claimed and that one skilled in the art would not recognize the claims as obvious variations of the patented invention.

The rejection should be reversed¹.

¹ To the extent the double patenting rejection is upheld as to any claim, the application should be remanded to allow Applicant to either cancel the offending claim(s) or file a terminal disclaimer.

Issue E: The Examiner has erred in rejecting claims 1-51 under the judicially created doctrine of double patenting over drawing figures 1-12 of U.S. Patent No. D400,012 to Apps.

Appellant disagrees with the double-patenting rejection over the design patent. “The law provides that, in some very rare cases, obvious-type double patenting may be found between design and utility patents. *See Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 939-40, 220 USPQ 481, 487 (Fed. Cir. 1983) (noting that, while theoretically possible, ‘[d]ouble patenting is rare in the context of utility versus design patents’); *In re Thorington*, 418 F.2d 528, 536-37, 163 USPQ 644, 650 (CCPA 1969) (Double patenting between a design and utility patent is possible ‘if the features producing the novel aesthetic effect of a design patent or application are the same as those recited in the claims of a utility patent or application as producing a novel structure.’). In these cases, a ‘two-way’ test is applicable. *See Carman*, 724 F.2d at 940, 220 USPQ at 487. Under this test, the obviousness-type double patenting rejection is appropriate only if the claims of the two patents cross-read, meaning that ‘the test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, and vice versa.’ *Id.*, 220 USPQ at 487.” *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999).

The claims of the current application, which can cover multiple embodiments, would not render claim of the design patent obvious - - or vice versa. Like the claims in *Dembiczak*, the pending claims in this utility patent application do not render the design patent obvious.

The Examiner has not even set forth a *prima facie* case of obviousness. Since this double-patenting rejection requires two-way obviousness, it is twice as burdensome to expect Appellant to come up with multiple possible obviousness theories, one of which may accurately represent the Examiner's undisclosed *prima facie* case, and then rebut these hypotheticals one-by-one. However, it is clear that there can be made embodiments covered by the utility claims that are not made obvious by the design claim. Thus, the two-way test is not met.

Although a double-patenting rejection of a utility patent application over a design patent is supposed to be “very rare” (*Dembiczak, supra*), the Examiner appears to be

routinely rejecting utility applications over their design patent counterparts simply because the drawings of the design patent illustrate something that would be covered by the utility claims. (See, for example, Office Action mailed 4/2/03 from commonly assigned Application Serial No. 09/780,073, pages 6-7, attached as Exhibit A and Office Action mailed 5/14/03 from commonly assigned Application Serial No. 10/145,226, pages 4-6, attached as Exhibit B.) However, this is not the proper test for double-patenting. The proper test for double-patenting requires a comparison of what the two patents cover, whether they are utility patents or design patents. In this case, what must be compared (in a two-way test) are the present utility claims and the claim of the design patent (not the entirety of the drawings) to confirm the two-way coverage. The Examiner has not done so, and any attempt is doomed to failure.

The rejection should be reversed².

² To the extent the double patenting rejection is upheld as to any claim, the application should be remanded to allow the applicant to either cancel the offending claim(s) or file a terminal disclaimer.

IX. CONCLUSION

For the reasons discussed above, Applicants believe the recited rejections of claims 1-51 are in error. Thus, reversal is respectfully requested.

A check in the amount of \$ 430.00 is enclosed to cover the appeal fee of \$320 under the provisions of 37 C.F.R. § 1.17(c) and the fee of \$110 for a one month extension. Please charge any additional fee or credit any overpayment in connection with this filing to our Deposit Account No. 02-3978.

Respectfully submitted,

WILLIAM PATRICK APPS

By: 

Robert C. Brandenburg
Registration No. 29,048
Attorney for Applicant

Date: Sept 29, 2003

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
Phone: 248-358-4400
Fax: 248-358-3351
Enclosure - Appendix

IX. APPENDIX - CLAIMS ON APPEAL

1. A low depth nestable display crate for bottle carriers comprising:
a floor for supporting the bottle carriers; and
a wall structure having endwalls and sidewalls extending around the periphery
of said floor and comprising

a lower wall portion including an exterior surface along said sidewalls, the
lower wall portion further including interior bottle carrier support surfaces connected to said
floor,

a double thickness upper wall portion comprising spaced tooth members
extending upward from said lower wall portion and defining display openings between said
tooth members along said sidewalls, wherein said display openings are sized to reveal labels
on the bottle carries for displaying the bottle carriers in a loaded crate, and

a handle bar integrally molded with said tooth members along said endwalls and
said lower wall portion defining a cut-out, said cut-out providing said handle bar complete
clearance below said handle bar, and complete clearance above said handle bar from a stacked
crate thereabove, and provide sufficient clearance between said handle bar and the bottle
carriers loaded in said crate to enable a user's hand to encircle said handle bar.

2. The crate of claim 1, comprising interior teeth panels provided on the
interior side of said tooth members, said teeth panels being flat to provide lateral support to
the bottle carriers loaded in said crate. *Combo?*

3. The crate of claim 1, wherein said interior bottle carrier support surfaces
of said lower wall portion have openings disposed therebetween.

4. The crate of claim 1, wherein said tooth members extend above and
inwardly from said lower wall portion to form a shoulder therebetween.

5. The crate of claim 1, further comprising nesting ribs provided within at least one of said tooth members to bear against a top surface of a corresponding tooth member in a crate nested therebelow.

6. The crate of claim 1, wherein the spaced tooth members extending along said sidewalls have a trapezoidal shape.

7. The crate of claim 1, wherein the spaced tooth members extending along said sidewalls are upwardly tapered.

8. The crate of claim 1, wherein the lower wall portion along the sidewalls between the spaced tooth members has a flat interior surface.

9. The crate of claim 1, wherein the lower wall portion along the sidewalls between the spaced tooth members includes an exterior wall member having an outer surface and an inner surface, the outer surface defined by said exterior surface, and the inner surface having a plurality of ribs extending perpendicularly therefrom.

10. The crate of claim 1, wherein the lower wall portion between the spaced tooth members has a top surface extending between the exterior surface and the interior surface.

11. The crate of claim 10, wherein the top surface is generally flat.

12. The crate of claim 1, wherein the tooth members have an upper portion, and a bottom portion having a relatively greater width than the upper portion.

13. The crate of claim 1, wherein the exterior surface of the lower wall portion is solid.

14. The crate of claim 1, wherein said tooth members include interior teeth panels provided on the interior side thereof, the interior teeth panels being generally co-planar with the interior bottle carrier support surfaces.

15. A low depth nestable display crate for bottle carriers comprising:
a floor having an upper surface for supporting the bottle carriers, and a lower surface; and

a pair of opposed endwalls and a pair of opposed sidewalls extending around the periphery of said floor,

the sidewalls comprising a sidewall lower wall portion having an exterior surface and further having interior bottle carrier support surfaces connected to said floor, the sidewall further comprising a double thickness upper wall portion including spaced-apart sidewall tooth members extending upwardly from said sidewall lower wall portion and defining display openings between said sidewall tooth members, wherein said display openings are sized to reveal labels on the bottle carriers for displaying the bottle carriers in a loaded crate,

the endwalls comprising a handle bar integrally molded with endwall tooth members and an endwall lower wall portion including a cut-out, said cut-out providing said handle bar clearance below said handle bar, and a clearance above said handle bar from a stacked crate thereabove, and provide sufficient clearance between said handle bar and the bottle carriers loaded in said crate to enable a user's hand to completely encircle said handle bar.

16. The crate of claim 15, wherein said tooth members include interior teeth panels provided on the interior side thereof, said teeth panels being flat to provide lateral support to the bottle carriers loaded in said crate.

17. The crate of claim 15, wherein said tooth members include interior teeth panels provided on the interior side thereof, the interior teeth panels being generally co-planar with the interior bottle carrier support surfaces.

Appendix

Page 3
← Combo is not being claimed
the int. bottle carrier support surfaces are not a portion of the bottle carrier but a part of sidewall of the crate

18. The crate of claim 15, wherein said interior surfaces of said sidewall lower wall portion have openings disposed therebetween.

19. The crate of claim 15, wherein said tooth members along the sidewalls extend above and inwardly from said sidewall lower portion to form a shoulder therebetween.

20. The crate of claim 15, further comprising nesting ribs provided within at least one of said tooth members to bear against a top surface of a corresponding tooth member in a crate nested therebelow.

21. The crate of claim 15, wherein the spaced tooth members extending along said sidewalls have a trapezoidal shape.

22. The crate of claim 15, wherein the spaced tooth members extending along said sidewalls have an upper edge with at least one rounded portion.

23. The crate of claim 15, wherein the sidewall lower wall portion between the spaced tooth members has a top surface extending between the exterior surface and the interior surface.

24. The crate of claim 23, wherein the top surface is generally flat.

25. The crate of claim 15, wherein the tooth members have an upper portion, and a bottom portion having a relatively greater width than the upper portion.

26. The crate of claim 15, wherein the interior bottle carrier support surfaces are defined by flat panels.

27. The crate of claim 15, wherein the sidewall lower wall portion between the spaced tooth members includes an outer wall member having an outer surface and an inner surface, the outer surface defined by said exterior surface, and the inner surface having a plurality of ribs extending inwardly perpendicular therefrom.

28. A low depth nestable display crate for bottle carriers comprising:
a floor having an upper surface for supporting the bottle carriers, and a lower surface; and

a wall structure having endwalls and sidewalls extending around the periphery of said floor and comprising

a lower wall portion including an exterior surface along said sidewalls and interior portions connected to said floor upper surface, wherein the exterior surface and the interior portions are connected by at least one member extending therebetween,

a double thickness upper wall portion comprising spaced tooth members extending upwardly from said lower wall portion and defining display openings between said tooth members along said sidewalls, wherein said display openings are sized to reveal labels on the bottle carriers for displaying the bottle carriers in a loaded crate, and

a handle bar integrally molded with said tooth members along said endwalls and said lower wall portion defining a cut-out, said cut-out providing said handle bar with complete clearance below said handle bar, and complete clearance above said handle bar from a stacked crate thereabove, and providing sufficient clearance between said handle bar and the bottle carriers loaded in said crate to enable a user's hand to encircle said handle bar.

29. The crate of claim 28, wherein the at least one member extending between the exterior surface and the interior portions is a lower wall top surface.

30. The crate of claim 29, wherein the lower wall top surface is generally flat.

31. The crate of claim 28, wherein the lower wall portion along the sidewalls between the spaced tooth members includes an exterior wall member having an outer surface and an inner surface, the outer surface defined by said exterior surface, and the inner surface having a plurality of ribs extending perpendicularly therefrom.

32. The crate of claim 28, wherein the exterior surface along the sidewalls is solid.

33. The crate of claim 28, comprising interior teeth panels provided on the interior side of said tooth members, said teeth panels being flat to provide lateral support to the bottle carriers loaded in said crate.

34. The crate of claim 28, comprising interior teeth panels provided on the interior side of said tooth members, and having a cut-out disposed below the interior teeth panels.

35. The crate of claim 28, wherein said tooth members extend above and inwardly from said lower wall portion along the sidewalls to form a shoulder therebetween.

36. The crate of claim 28, further comprising nesting ribs provided within at least one of said tooth members to bear against a top surface of a corresponding tooth member in a crate nested therebelow.

37. The crate of claim 28, wherein the spaced tooth members extending along said sidewalls have a trapezoidal shape.

38. The crate of claim 28, wherein the spaced tooth members extending along said sidewalls have an upper edge with at least a portion thereof being rounded.

39. The crate of claim 28, wherein the tooth members have an upper portion, and a bottom portion having a relatively greater width than the upper portion.

40. A low depth nestable display crate for six-pack bottle carriers comprising:

a floor for supporting the bottle carriers; and

a wall structure having endwalls and sidewalls extending around the periphery of said floor and comprising

a lower wall portion including an exterior wall member along said sidewalls, the exterior wall member having an outer surface and an inner surface, the inner surface having a plurality of rib members projecting perpendicularly therefrom, the lower wall portion further having interior portions for supporting bottle carriers, the interior portions connected to said floor,

an upper wall portion comprising spaced tooth members extending upward from said lower wall portion and defining display openings between said tooth members along said sidewalls, wherein said display openings are sized to reveal labels on the bottle carriers for displaying the bottle carriers in a loaded crate, and

a handle bar integrally molded with said tooth members along said endwalls and said lower wall portion defining a cut-out, said cut-out providing said handle bar clearance below said handle bar, and clearance above said handle bar from a stacked crate thereabove, and provide sufficient clearance between said handle bar and the bottle carriers loaded in said crate to enable a user's hand to encircle said handle bar.

41. The crate of claim 40, comprising interior teeth panels provided on the interior side of said tooth members, said teeth panels being flat to provide lateral support the bottle carriers loaded in said crate.

42. The crate of claim 40, wherein said interior portions of said lower wall portion have openings disposed therebetween.

43. The crate of claim 40, wherein said tooth members extend above and inwardly from said lower wall portion to form a shoulder therebetween.

44. The crate of claim 40, further comprising nesting ribs provided within at least one of said tooth members to bear against a top surface of a corresponding tooth member in a crate nested therebelow.

45. The crate of claim 40, wherein the spaced tooth members extending along said sidewalls have a trapezoidal shape.

46. The crate of claim 40, wherein the spaced tooth members extending along said sidewalls have an upper edge defined at least partially by a rounded surface.

47. The crate of claim 40, wherein the tooth members have an upper portion, and a bottom portion having a relatively greater width than the upper portion.

48. The crate of claim 40, wherein the exterior surface of the exterior wall member is solid.

49. The crate of claim 40, wherein the plurality of rib members connect the exterior wall member and the interior portions.

50. A low depth nestable display crate for six-pack bottle carriers comprising:

a floor for supporting the bottle carriers; and

a doubled thickness wall structure having endwalls and sidewalls extending around the periphery of said floor and comprising

a lower wall portion including an exterior surface along said sidewalls, and further including interior bottle carrier support surfaces connected to said floor,

an upper wall portion comprising spaced tooth members extending upward from said lower wall portion and defining display openings between said tooth members along said sidewalls, wherein said display openings are sized to reveal labels on the bottle carriers for displaying the bottle carriers in a loaded crate, and

a handle bar integrally molded with said tooth members along said endwalls and said lower wall portion defining a cut-out, said cut-out providing said handle bar complete clearance below said handle bar, and complete clearance above said handle bar from a stacked crate thereabove, and provide sufficient clearance between said handle bar and the bottle carriers loaded in said crate to enable a user's hand to completely encircle said handle bar.

51. A low depth nestable display crate for bottle carriers comprising:

a floor for supporting the bottle carriers; and

a wall structure having endwalls and sidewalls extending around the periphery of said floor and comprising

a lower wall portion including an exterior surface along said sidewalls, the lower wall portion further including interior bottle carrier support surfaces connected to said floor,

a double-walled upper wall portion comprising tooth members spaced apart from each other and extending upwardly from said lower wall portion, the tooth members having an upper surface with at least a portion thereof being rounded, the spaced apart tooth members defining display openings therebetween along said sidewalls, wherein said display openings are sized to reveal labels on the bottle carriers loaded in the crate, and

a handle bar integrally molded with said tooth members along said endwalls and said lower wall portion along the end walls including a cut-out for providing said handle bar complete clearance below said handle bar, and complete clearance above said handle bar from a stacked crate thereabove.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,073	02/09/2001	William P. Apps	RPC 0557 PUS	7630

7590 04/02/2003
KONSTANTINE J. DIAMOND
4010 E. 26th STREET
LOS ANGELES, CA 90023

EXAMINER

CASTELLANO, STEPHEN J

ART UNIT PAPER NUMBER

3727

DATE MAILED: 04/02/2003

5/2 - sn
6/2 - sn
7/2 - sn

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/780,073

Applicant(s)

APPS, WILLIAM P.

Examiner

Stephen J. Castellano

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

RECEIVED
REHRIG PACIFIC COMPANY

APR 7 2003

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

Art Unit: 3727

The finality of the previous office action has been withdrawn.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-18 and 21-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation "the upper edge" of the band side detail in the second to last line. There is insufficient antecedent basis for this limitation in the claim because it can't be determined if "the upper edge" refers to the "uppermost edge" previously recited in the claim. The claim is ambiguous since the upper edge could refer to any upper edge and upper edge which is not an uppermost edge or an uppermost edge.

Claim 22 recites the limitation "the parallel portions" in lines 9 and 10. There is insufficient antecedent basis for this limitation in the claim.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6, 8, 9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Carroll ('213)(Carroll).

Carroll discloses a low depth nestable tray which is inherently capable of holding containers, the tray comprises a floor structure with container support areas and a low depth wall structure comprising columns (portions of the outer zig-zag bands which attach the inner zig-zag

Art Unit: 3727

band to the floor structure) and a band (the annular inner zig-zag band), the band has side and end portions spaced above the floor structure and connected to the floor structure by the columns, the band is contoured downwardly to form a band corner portion that directly connects to the floor structure at each corner of the tray. A rib is formed on the exterior surface of each band corner portion by another portion of the outer zig-zag band near the ends of the zig-zag bands which connects with the band corner portion and a platform is formed on the top edge of each band corner portion. The bands are contoured downwardly at an angle appearing to be 45 degrees which is approximately 50 degrees. The band is contoured downwardly along the side of the tray to form a band side detail connected to the floor structure.

Claims 6-18 and 21-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Apps ('925) (Apps).

Apps discloses a low depth nestable tray for containers, said tray having a low depth wall structure comprising a plurality of columns (18) and a band (rail 16 and corner posts 20) having side and end portions spaced above the floor, the corner portion is formed by (posts 20) and wherein the band is contoured downwardly to form a band corner portion that directly connects to the floor structure at each corner of said tray. One vertical edge of the corner post 20 is an end portion of the band the other vertical edge of the corner post is a side portion of the band. A rib (21) is located on the exterior surface of each corner post and a platform is formed at the top edge of each corner post. Individual support columns (18) on the side of the tray can be considered to be part of the band that is contoured downwardly along the side of the tray to form a band side detail that connects to the floor structure at the side of the tray. Each column has an inner column surface which projects inward, and an outer column surface which is recessed

Art Unit: 3727

inward to receive therein the inner column surface of an adjacent below-nested tray. Figures 5 and 6 disclose the band side details and band end details which extend below the uppermost portions of the band.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 12-15, 17-19 and 21-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carroll.

Carroll discloses the invention except for an uppermost edge of the corresponding band corner portion is not an uppermost surface of the wall structure at the corresponding band corner portion as stated in claims 1 and 22, the top edge of the band central portion is not the uppermost surface of the wall structure at the band central portion as stated in claim 7 and the uppermost edge of the band side detail is not the uppermost surface of the wall structure at the band side detail as stated in claim 13. See MPEP 2144.04 Part II, elimination of an element. It would have been obvious to remove an element with retention of the elements function. Therefore, it would have been obvious to remove the uppermost band which is parallel with the floor about its entire circumference and obvious to remove portions of the outer zig-zag band at the corner portions or any part of the outer zig-zag band which extends above a corresponding adjacent portion of the inner zig-zag band since the inner zig-zag band provides sufficient support to the sides of items stacked in the tray of Carroll and the elimination of the uppermost band and the portions of the outer zig-zag band would save material cost of resin used in

Art Unit: 3727

manufacturing and to save weight making transport of the trays more economical. Note that the lower portions of the outer zig-zag band which act as columns to attach the inner zig-zag band to the floor and lower portions which form ribs on the exterior of the band corner portions are not removed.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Apps in view of David.

Apps discloses the invention except for an angle of 50 degrees as the downward contour angle of the band to form band corner portions and the band central portion. David teaches a crate wherein V-shaped structures are used to secure a band to a floor structure, the V-shaped structures have two arms (34, 35). The V-shaped structure show that a side band and a floor structure can be connected securely with an integrally molded V-shaped structure as shown in Fig. 6 where the two arms adjacent the corner, one associated with the end wall and the other associated with the side wall, and other structures are located centrally to the side, connect the band and floor with a downwardly contoured structure where the angle is about 60 degrees which is approximately 50 degrees. It would have been obvious to modify the corner portions and band central portion to have a 50 degree downward contour in order to have a corner portion or central portion which covers a greater peripheral extent of the side wall to keep the contents from slipping out of the container between the band and the floor.

Claims 11, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carroll in view of Apps.

Carroll discloses the invention except for the inwardly projecting inner column surface and the corresponding recessed outer surface. Apps teaches columns 18 with inwardly

Art Unit: 3727

projecting inner surfaces and corresponding recessed outer surfaces. It would have been obvious to replace the columns of Carroll with Apps' columns in order to provide columns with nesting structure which restrict movement when in the nested configuration and which assist in aligning the trays when the trays are being nested.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-28 are rejected under the judicially created doctrine of double patenting over claims 1-13 of U. S. Patent No. 6,186,328 and drawing figures 1-10 of U.S. Patent No. D404,204 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patents.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A tray for supporting cans comprising a floor structure and a low depth wall

Art Unit: 3727

structure, the wall structure having a plurality of columns and a band member with side and end portions.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

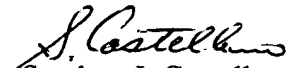
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Castellano whose telephone number is 703-308-1035.

The examiner can normally be reached on M-Th 6:30-5.

Art Unit: 3727

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Stephen J. Castellano
Primary Examiner
Art Unit 3727

sjc
March 31, 2003



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/145,226	05/13/2002	Trenton M. Overholt	RPC 0510 CON	5708

7590 05/14/2003
KONSTANTINE J. DIAMOND
4010 E. 26th St.
Los Angeles, CA 90023

RECEIVED
REHRIG PACIFIC COMPANY
MAY 19 2003

R

EXAMINER

CASTELLANO, STEPHEN J

ART UNIT PAPER NUMBER

3727

DATE MAILED: 05/14/2003

6/14 S
7/14 S
8/14 S

Please find below and/or attached an Office communication concerning this application or proceeding.

11/14 bmo S

Office Action Summary

Application No.

10/145,226

Applicant(s)

OVERHOLT, TRENTON M.

Examiner

Stephen J. Castellano

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some.* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3727

Claims 17 and 20-24 are objected to as containing awkward grammatical constructions which makes the claim not fully understood. In claim 17, in line 2, it appears that a conjunction is needed after "thereon." In claim 20, in line 2, it appears that a conjunction is needed after "base."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16, 17, 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites the limitation "the second walls" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "the second walls" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 26 recites the limitation "the end walls" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 27 recites the limitation "the end walls" in line 2. There is insufficient antecedent basis for this limitation in the claim.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3727

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12-18, 26 and 27 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Jacques et al. ('342)(Jacques 1).

Claims 12-31 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Overholt et al. ('054)(Overholt).

Claim 12-14, 25, 26, 28, 29 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Jacques et al. ('420)(Jacques 2).

Jacques 2 discloses a collapsible container (see Fig. 8-15), in Fig. 9 several pairs of opposed upstanding members can be recognized, the corner posts 240 are upstanding members and the upstanding edges 244 and 246 of the base form upstanding members between each adjacent pair of hinge pintles 230, 232, respectively, the corresponding sidewalls have recesses which match with the corner posts and the upstanding members formed between hinge pintles, in Fig. 8 either pair of side walls discloses a central portion having a substantially smooth, non-apertured inner surface wherein the central portion is located at the mid-length of the side wall either close to the top edge or close to the bottom edge (the central portion is selected so that it is relatively large as compared to the peripheral portion) and the peripheral portion of the inner surface of either pair of side walls includes a plurality of apertures either at the longitudinal ends or along the bottom edge of the side walls (the peripheral portion is selected such that it is relatively small as compared to the central portion), the base discloses a longitudinally extending curved portion extending from an upper surface as is shown by viewing the back right wall of Fig. 8 where it joins the base, the base has an upward curvature.

Art Unit: 3727

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15, 27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacques 2 in view of Jacques 1.

Jacques 2 discloses the invention except for the ribs. Jacques 2 teaches ribs at the upper edge of the inner surface of the side walls. It would have been obvious to add the ribs to the inner surface in order to strengthen the inner surface to prevent the stress of impacts from creating stress cracks or tears at the inner surface of the inner surface of the sidewalls as this portion of the container is most susceptible to use and wear.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jacques 1 and Jacques 2 in view of Capper.

Jacques 1 and Jacques 2 disclose the invention except for the concave shape of the inner surface of the central portion. Capper discloses a concave inner surface. It would have been obvious to provide a concave inner surface to more closely conform to the curved shape of the objects stored within the container.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

Art Unit: 3727

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-31 are rejected under the judicially created doctrine of double patenting over claims 1-22 of U. S. Patent No. 6,386,388 to Overholt, over claims 1-21 of U.S. Patent No. 6,398,054 to Overholt et al. and over Fig. 1-6 of U.S. Design Patent No. D446,392 to Overholt et al. since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A collapsible container arranged to hold an object having a curvature along its length, comprising a base, a first pair of opposed side walls and a second pair of opposed side walls.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 12-31 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-19 of copending Application No. 10/163,004. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common

Art Unit: 3727

subject matter, as follows: A collapsible container arranged to hold an object having a curvature along its length, comprising a base, a first pair of opposed side walls and a second pair of opposed side walls.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Applicant's arguments with respect to claims 12-31 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Art Unit: 3727

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Castellano whose telephone number is 703-308-1035.

The examiner can normally be reached on M-Th 6:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Stephen J. Castellano
Primary Examiner
Art Unit 3727

sjc
May 12, 2003